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Norbert Niebert

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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

PAPER NUMBER

3621

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,529	Applicant(s) NIEBERT ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/15/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20090924 for reference purposes only.
2. This Office Action is in response to the original filing of 15 June 2006, and the subsequent National Stage documents filed 10 May 2007 and 7 August 2007.
3. The claims submitted on 10 May 2007 are understood to be the original claims, as submitted in the original foreign application; the claims submitted on 15 June 2006 are understood to amend these claims. Therefore, the claims submitted 15 June 2006 (listing claims 1-20 as cancelled, and 21-42 as new) have been examined.
4. All references to the capitalized version of “Applicant” refer specifically to the Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
5. Claims 21-42 are pending.
6. Claims 21-42 have been examined.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 39-41 are rejected under 35 U.S.C. §101 because they are directed to non-statutory subject matter.

9. Under the broadest reasonable interpretation standard, claim 39 recites a computer program only. "Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention¹. Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

10. In this particular case, the Examiner finds that under the broadest reasonable interpretation, "unit" is interpreted as software only. Because this interpretation includes software only, the claim is not within one of the four statutory classes of invention, and are therefore rejected under 35 U.S.C. §101.

11. With respect to claims 40, the claim "medium" could be interpreted by a person of ordinary skill in the art as signal over the airwaves.

¹ 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" (or products) while the first category defines "actions" (*i.e.*, inventions that consist of a series of steps or acts to be performed).

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 22 and 42 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 22 recites “retrieving, by the second unit, either the media file or the associated usage rights data, not transferred from the first user unit to the second user unit from the central interface unit” (lines 1-3). A person having ordinary skill in the art would not understand:

- a. whether the data is transferred from the central interface unit directly to the second unit, avoiding the first unit, or
- b. whether the data is NOT transferred via the central interface unit to the second unit.

15. Claim 42 is indefinite because it is considered a hybrid claim. See MPEP §2173.05(p) II.

c. In particular, because claim 42 recites both “[A] system” and methods steps, the claim does not apprise a person of ordinary skill in the art of its scope. Additionally, the claims are directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

d. For example, claim 42 recites “A system comprising a computer processor” In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a product claim. Alternatively, claim 42 also recites the method steps of “transferring at least one of the media file,” “limiting

Art Unit: 3621

access," and "coupling at least one of the first and second using units" One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to include method steps. In light of this conflicting evidence, the scope of the claim is not known. Additionally, a person of ordinary skill in the art could reasonably interpret claim 42 to be drawn to both a product or process.

e. Therefore in accordance with §2173.05(p) II. which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. For prior art purposes, the Examiner will interpret claim 42 as a product only.

16. The Examiner finds that because the claim is indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though claims may be indefinite, the claim is construed and the prior art is applied as much as practically possible.

Art Unit: 3621

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 21-25 and 39-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent Application 1 045 386 (“Herpel”) in view of United States Patent 7,222,104 (“Tadayon”).

19. As per claims 21 and 39-42, Herpel discloses:

20. transferring at least one of the media file and the associated usage rights data directly from the first user unit to the second user unit via a communication link between the first and second user units (§14 - “multimedia content item is copied to the secondary device”);

21. limiting access by the first user unit to the media file (§18 - “if the multimedia content item is no longer needed on the primary device, it can be physically deleted”);

22. providing access to the second user unit to the media file (§14 - “copied to the secondary device”).

23. Herpel does not explicitly disclose:

24. coupling at least one of the first and second user units over a communications network to the central interface unit;

25. logging, at the central interface unit, the transfer of at least one of the media file and its associated usage rights data to the second user unit.

Art Unit: 3621

26. Tadayon teaches:

27. coupling at least one of the first and second user units over a communications network to the central interface unit (figure 1, arrows between 130 and 150, 150 and 152);

28. logging, at the central interface unit, the transfer of at least one of the media file and its associated usage rights data to the second user unit (column 5, lines 36-41 - “transfer permission module 214 manipulates current user ID flag mobile 216 to reflect the exchange in current users of the content...”).

29. Tadayon teaches the coupling and logging features in order to create a system that allows for direct transfers of data, as well as the upkeep of log files which can better reflect the movement of said data. A person having ordinary skill in the art would see this as advantageous because it would create a more trustworthy system (in the event of data loss, the proper permissions could be read in the log file), and users would be more likely to use it, creating a more profitable system.

30. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Herpel the logging and coupling as taught by Tadayon, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more trustworthy system.

31. As claim 22 is best understood by the Examiner, Herpel in view of Tadayon discloses as above, and further discloses:

Art Unit: 3621

32. retrieving, by the second unit, either the media file or the associated usage rights data, not transferred from the first user unit to the second user unit from the central interface unit (Tadayon, column 6, lines 52-55 - “digital works can be transferred directly [from] user to user or through a centralized system”).

33. As per claims 23-25, Herpel in view of Tadayon discloses as above, and further discloses:

34. transferring at least one of the second media file and its associated usage rights data from the second user unit to the first user unit, limiting access by the second user unit to the second media file; providing access to the first user unit to the second media file, wherein the logging step further comprises the step of logging the transfer of at least one of the second media file and its associated usage rights data from the second user unit to the first user unit, transfer of at least one of the first media file and its associated usage rights data to the second user unit is part of a swap transaction conditioned upon the transfer of at least one of the second media file and its associated usage rights data to the first user unit, second user unit transfers more than one media file to the first unit as part of a swap transaction (Tadayon, column 5, lines 3-29 - “user 130 and user 132 desire to exchange their respective rights in content 210 and 310...”; the same actions are performed on the second user unit’s side in the “exchange” transaction).

35. Claims 26-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herpel in view of Tadayon, further in view of Official Notice.

Art Unit: 3621

36. As per claim 26, Herpel in view of Tadayon discloses as above, but does not explicitly disclose:

37. generating a dummy media file substituting at least one of the second media file and its associated usage rights data to satisfy the swap transaction conditions.

38. The Examiner takes Official Notice that dummy files were old and well-known in the art because it creates a mechanism by which users or programmers may test functionality of a program; by creating a dummy media file that has no consequence in reality, it allows a user or a programmer to test out swapping functionality, in order to make sure it works properly. A person having ordinary skill in the art would see this as advantageous because it would create a more reliable system that is able to be tested, even after being deployed. This, in turn, would lead to a more trustworthy system, which would be a more profitable system (as users would be more likely to use it).

39. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Tadayon and Herpel the concept of dummy files, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would lead to a more reliable and trustworthy system.

40. As per claim 27, Herpel in view of Tadayon discloses as above, but does not explicitly disclose:

Art Unit: 3621

41. transferring the media file to be transferred from the storage unit of the first user unit to the associated output buffer, and transferring the media file to be transferred from the output buffer of the transferring user unit to the input buffer of the second user unit.

42. The Examiner takes Official Notice that transferring to and from an buffers was old and well-known in the art because it allows for the burst-sending of data. Instead of sending as much data as possible each second, a buffer allows a computer program to send a continuous amount of data. This is much like a line for a rollercoaster - it queues up as much data as possible before sending it all at once, creating a more reliable system. A person having ordinary skill in the art would further find this to be advantageous because it would create a more reliable system where, if a connection were not available, the data could be queued up.

43. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Tadayon and Herpel the concept of buffering, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more reliable system.

44. As per claim 28, Herpel in view of Tadayon, further in view of Official Notice discloses as above, and further discloses:

45. updating a transfer log to reflect the removals and additions of the transferred media file (¶19 - “complete data base of multimedia content items at all times”).

Art Unit: 3621

46. As per claims 29 and 30, Herpel in view of Tadayon, further in view of Official Notice discloses as above, and further discloses:

47. polling a digital rights management system within the central interface unit by the transferring user unit, receiving a command or message from the digital rights management system by the transferring user unit to limit access by the transferring user unit to the transferred media file, polling a digital rights management system within the central interface unit by the receiving user unit, receiving a command or message from the digital rights management system by the receiving user unit to grant to the receiving user unit access to the received media file (Tadayon, column 6, lines 52-55 - “digital works can be transferred directly from user to user or through a centralized system”; column 6, lines 5-18 - “clearinghouse 150 can collect an electronic signature from user 132 and send any appropriate notices, such as a terminating notice, to user 130”).

48. As per claims 31-38, Herpel in view of Tadayon, further in view of Official Notice discloses as above, and further discloses:

49. preventing access to a transferred media file by a receiving user if the DRM system has associated the transferred media file with a third user unit, cryptographically associating each transferred digital media file with a receiving user unit (§15 - “assumes that decryption keys are valid only for a single storage device or a single player application”);

50. transferring the media file back to the transferring unit if the transfer is not ratified ();

51. providing a history log for integration into each media file that identifies at least one of previous owners and transfers of the media file, synchronizing the media file history log with the

Art Unit: 3621

logged transfers stored within the central interface unit (§19 - “complete data base of multimedia content items at all times”; §20-23 - “content descriptor consists of a number of flags including an original/copy flag...key for decryption...copy bits...media active bit”);

52. media file transferred with one or more usage restrictions (§9 - “rights associated to a multimedia content items and that includes a location-specific decryption key”);

53. transferring media file back to the transferring unit after a usage restriction condition associated with the transferred media file has been met, synchronize at least one of the media files and the associated usage rights data, if any, stored within each user unit with one or more databases within the central interface unit (Tadayon, column 5, line 66 - column 6, line 4 - “process returned content by a user, to obtain a refund...as an added usage right”; column 5, lines 25-30 - “can keep track of rights, fees, percentages, content owners, and current users”).

54. As per claim 33, Herpel in view of Tadayon discloses as above, but does not explicitly disclose:

55. transferring the transferred media file from the receiving unit back to the transferring unit if the transfer is not ratified.

56. The Examiner takes Official Notice that returning data when a transaction is not completed was old and well-known in the art because of the want to control all copies of a work. Both Tadayon and Herpel speak of the need to control works (Herpel; §19 - “can be physically deleted”); as such, a user that does not pay for a work should not be entitled to receive said work. Sending the work back to the transferring unit allows for a more profitable system where the content owners are more likely to be compensated for their work’s usage.

Art Unit: 3621

57. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Tadayon and Herpel the concept of sending data back upon a lack of ratification, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more profitable system.

Claim Interpretation

58. With respect to claim 30, the Examiner notes the following: “A ‘system’ is an ‘apparatus.’” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993) citing *In re Walter*, 618 F.2d 758, 762 n.2, 205 USPQ 397, 402 n.2 (CCPA 1980). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner’s position that Applicants’ system claim (*i.e.* claim 30) is a “product,” “apparatus,” or more specifically, a “machine” claim.

59. In accordance with MPEP §2111, the Examiner has interpreted the meaning of claim limitations in accordance with their "broadest reasonable interpretation", unless such terms have been defined in the specification.

60. The Examiner finds that because the examined claims (*i.e.* claims 21-42) recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because all examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner

Art Unit: 3621

concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

61. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

f. **Configure:** “To initialize a device so that it operates in a particular way. For instance, a customer may configure a device so the device never requests data link confirmations, using a variety of mechanisms (e.g. parameters in NVRAM, parameters in ROM, dip switches, or hardware jumpers).” The Authoritative Dictionary of IEEE Standards Terms, 7th Ed., IEEE, Inc., New York, NY, 12/2000.

g. **Configuration:** “(1) (A) The arrangement of a computer system or component as defined by the number, nature, and interconnection of its constitute parts. ... (C) The physical and logical elements of an information processing system, the manner in which they are organized and connected, or both. *Note:* May refer to a hardware configuration or software configuration.” Id.

h. **Unit:** “(6)(C)(software) A software component that is not subdivided into other components. *Note:* The terms “module,” “component,” and “unit” are often used interchangeably or defined to be sub-elements of one another in different ways depending upon the context”. Id.

Art Unit: 3621

- i. **Medium** “(5) (information transfer) In data communications, a path over which communication flows, *Note: Medium is the singular form of media.*” Id.

62. Applicants are reminded that should the prior art rejections noted above be overcome by amendment/argument, the claims are nevertheless replete with functional language. While there is nothing inherently wrong with optional and/or functional language, this language does not ordinarily assist in overcoming the prior art. See MPEP §2114.

Conclusion

63. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

64. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

65. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

Art Unit: 3621

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621